

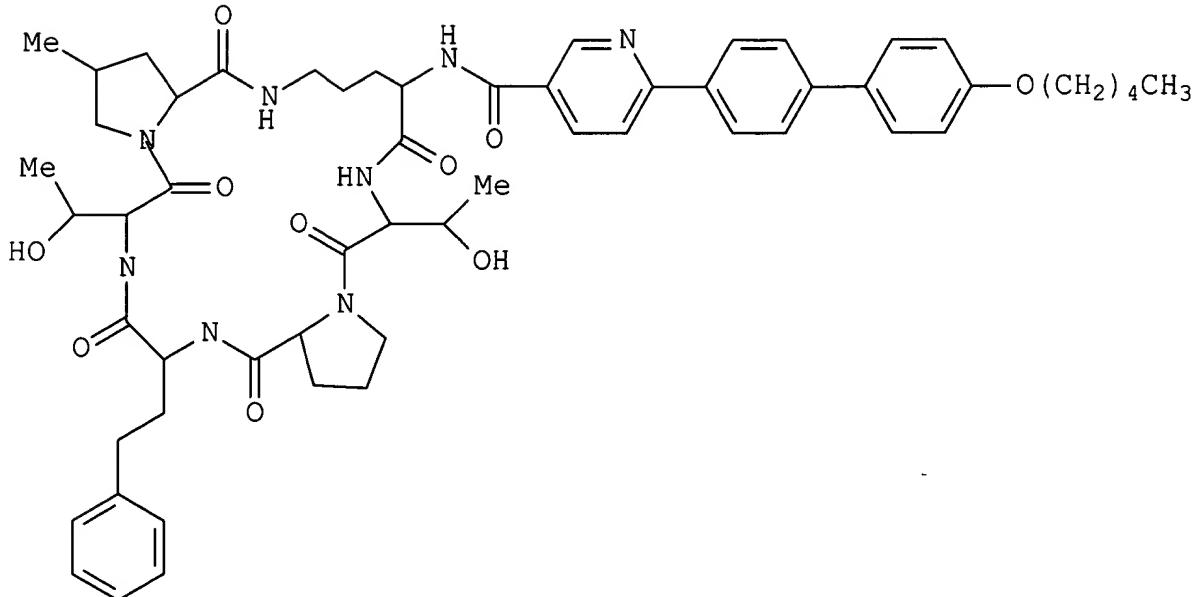
REMARKS

Claims 1-4, 6-7, 11-12, 14-16, 18, 20, and 24 are pending in the present application. Claims 6-7, 11-12, 14-16, and 24 are allowed. Claims 1 and 20 are amended. Claim 25 is canceled. Support for the subject matter added to claims 1 and 20 is found in the specification, such as in the listing of constituents on pages 13-14. No new matter is inserted into the application.

Advisory Action

On page 2 of the Advisory Action dated October 14, 2004, the Examiner asserts that the amendments to the claims proposed in the Reply after Final under 37 C.F.R. § 1.116 filed on September 27, 2004, would raise a new issue under 35 U.S.C. § 112, first paragraph.

Specifically, the Examiner asserts that there is no support in the specification to exclude the compound of



from the claims. Recitation of this compound is deleted from claims 1 and 20. As such, the Examiner's argument is rendered moot and no rejection under 35 U.S.C. § 112, first paragraph is warranted.

In addition, the Examiner argues that there is no support in the specification to exclude "a single bond" and "CH₂" from the definition of X. Applicants respectfully disagree, and respectfully submit that such a rejection would be contrary to established case law of In re Johnson, 194 USPQ 187 (CCPA 1977), and therefore clearly improper.

In In re Johnson, appellants appealed the decision of the USPTO Board of Appeals affirming rejection of appellant's claims under 35 U.S.C. § 112, first paragraph, for lack of written description. The application at issue disclosed linear thermoplastic polyarylene

polyether polymers having the general formula -O-E-O-E'-. Appellant's application disclosed several species of the polyarylene polymers, including two species (designated species [1] and [2] by the court) later found to be in the prior art and the subject of a lost interference count. Appellants amended their broadest claim to exclude the non-novel subject matter by inserting a negative proviso specifically excluding species [1] and [2]. The Examiner and Board of Appeals rejected the claims, stating that the negative provisos were not "described" in the application and therefore constituted new matter. The Board reasoned that appellants had created an "artificial genus" by attempting to exclude the prior art by negative proviso.

Upon review, the CCPA overturned the rejection ruling that ample support for the exclusion of the two species was found in the specification. The court specifically rejected the Board's notion that an artificial genus was created, stating that a specification that describes the whole necessarily describes the part remaining. The court emphasized that "appellants are merely excising the invention of another, to which they are not entitled, and are not creating an 'artificial subgenus' or claiming 'new matter.'" In re Johnson, at 196. The court further enunciated:

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

Id.

In summary, under In re Johnson, it is permissible to explicitly exclude alternative elements which are positively recited in the specification. Thus, since "a single bond" and "CH₂" are positively recited in the instant specification, they can be specifically excluded from the definition of X.

For these reasons, any rejection of the currently amended claims under 35 U.S.C. § 112, first paragraph is clearly not proper.

Rejection under 35 U.S.C. § 102

Henle '611

Claims 1-4 and 20 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Henle '611 (U.S. Patent 5,693,611). Applicants respectfully traverse. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Claims 1 and 20, as amended, do not encompass the compounds disclosed by Henle '611. In particular, the amended claims recite the substituents on ring C. As such, the instant claims do not recite the compound of Example 6 disclosed in Henle '611.

For this reason, Henle '611 fails to anticipate the present invention. Withdrawal of the instant rejection is therefore respectfully requested.

Lowe '766

Claims 1, 3-4, 18, and 20 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Lowe '766 (WO 98/24766). Applicants respectfully traverse. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Claims 1 and 20 do not encompass the compounds disclosed by Lowe '766. In particular, the terms "a single bond" and "-CH₂-" are deleted from the definition of X. As such, Examples 1 and 3 disclosed in Lowe '766 do not fall within the scope of the amended claims.

For this reason, Lowe '766 fails to anticipate the present invention. Withdrawal of the instant rejection is therefore respectfully requested.

Conclusion

Applicants respectfully submit that the above remarks and/or claim amendments render the present application into condition for allowance. The Examiner is respectfully requested to issue a Notice of Allowance indicating that claims 1-4, 6-7, 11-12, 14-16, 18, 20, and 24 are allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

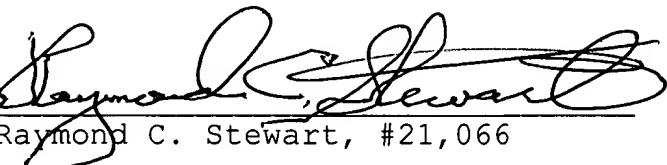
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

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required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Raymond C. Stewart, #21,066

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

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RCS/KLR
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